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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,020	08/23/2000	Robert Wallach	4090-4001	2332

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EXAMINER
FRENEL, VANEL

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/645,020	WALLACH ET AL.
	Examiner	**Art Unit**
	Vanel Frenel	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _08 September 2003_ .

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-70_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-70_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
           application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) ☐ Other:

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the Amendment filed 09/08/03. Claims 1,

10, 18-20 have been amended. Claims 21-70 are newly added. Claims 1-70 are

pending.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claims 1-17, 20, 30-59, 60-62, 66 and 70 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

The basic of this rejection is set forth in a two-prong test of :

(1) whether the invention is within the technology arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the

technological arts. More ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) that do not apply, involve, use, or advance the technological arts to

promote the "progress of science and the useful arts" (i.e., the physical sciences as

opposed to social sciences, for example) and therefore are found to be non-statutory

subject matter. For a process claim to pass muster, the recited process must somehow

apply, involve, use, or advance the technological arts. Looking at the claims 1-17, 20,

30-59, 60-62, 66 and 70 as a whole, nothing in the body of these claims recite any

structure of functionality to suggest that a computer performs the recited steps.

Examiner respectfully requests a common usage of terms such as "a computer

readable-medium" or a "computer system" are well taken to be within the statutory

categories within 35 U.S.C. 101 and therefore recommends using such terminologies.

As such, the above deficiencies may be cured by simply explicitly reciting that the

claimed method/process steps are embodied or implemented on a "computer system or

on a "computer-readable medium" (as appropriate), provided Applicant show proper

support for such recitations in the originally filed specification.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Joao (6,347,302) in view of Borghesi et al (5,950,169).

(A)   As per claim 1, Joao discloses a method for using a computer system to provide

an incentive relating to a sale or lease of an item (Col.5, lines 38-67 to Col.6, line 67)

comprising:

determining a class of items for which insurance is to be provided with a sale or

lease of one of the class of items (Col.1, lines 6-65);

determining a geographic region in which a buyer of one of the class of items must reside to receive the insurance (Col.2, lines 8-57);

storing the determined class of items and geographic region in said computer system (See Joao, Col.5, lines 38-67 to Col.6, line 67); and

paying an insurance premium for an insurance policy on behalf of the buyer (Col.7, lines 66-67 to Col.8, line 27. Joao does not explicitly disclose the insurance policy covering an item from the class of items after a sale or lease of the item to the buyer residing in the geographic region.

However, this feature is known in the art, as evidenced by Borghesi. In particular, Borghesi suggests the insurance policy covering an item from the class of items after a sale or lease of the item to the buyer residing in the geographic region (See Borghesi, Col.9, lines 18-67 to Col.10, line 28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(B)   As per claim 2, Borghesi discloses the method wherein the item is an automobile of a particular make and a model (Col.9, lines 57-67 to Col.10, line 28).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(C)   As per claim 3, Borghesi discloses the method wherein the insurance policy covers

comprehensive losses relating to the item (Col.10, lines 6-67).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(D)   As per claim 4, Borghesi discloses the method wherein the insurance policy covers collision losses relating to the item (Col.9, lines 7-67 to Col.10, line 28).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(E)   As per claim 5, Borghesi discloses the method wherein the insurance policy is provided without consideration of further characteristics of the buyer (Col.9, lines 7-67).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(F) As per claim 6, Borghesi discloses the method wherein the insurance policy covers all users of the item (Col.15, lines 24-67 to Col.16, line 67).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(G)   As per claim 7, Joao discloses the method wherein the insurance policy remains in effect if the buyer moves from the geographic region (Col.2, lines 19-49).

(H)   As per claim 8, Borghesi discloses the method wherein said paying further comprises paying the insurance premium to an affiliate for the insurance policy (Col.2, lines33-67).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(I)   As per claim 9, Borghesi discloses the method wherein the insurance premium is the same for each of the class of items sold in the geographic region (Col.4, lines 1-38).

The motivation for combining the respective teachings of Joao and Borghesi are as discussed above in the rejection of claim 1, and incorporated herein.

(J)   As per claim 10, Joao discloses a method for using a computer system to provide an incentive relating to a sale or lease of an item, comprising:

receiving an indication of a class of items for which insurance is to be provided to a buyer residing in a geographic region (Col.1, lines 6-65);

storing said indication of a class of items in said computer system (See Joao, Col.5, lines 38-67 to Col.6, line 67);

completing a sale or lease of one of the class of items to a particular buyer

residing in the geographic region (Col.2, lines 8-57);

confirming that the buyer resides in the geographic region (Col.2, lines 20-

67); and providing, in a sales agreement relating to the sale or lease of the item (Col.2,

lines 58-67 to Col.3, line 21). Joao does not explicitly disclose a confirmation of a

provision of an insurance policy covering a loss relating to the item.

However, this feature is known in the art, as evidenced by Borghesi. In particular,

Borghesi suggests a confirmation of a provision of an insurance policy covering a loss

relating to the item (See Borghesi, Col.4, lines 20-67 to Col.5, lines 25; Col.17, lines 1-

50).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Borghesi within the system of Joao with the

motivation of providing insurance policies, products, services and/or coverage for

leased and /or rented entities, vehicle, premises, equipment and other appropriate

articles on, or over, a communication network such as on, or over, the Internet, the

World Wide Web and /or any other communications and /or network environment and

/or medium (See Joao, Col.5, lines 6-13).

(K)   As per claim 11, Borghesi discloses the method wherein a premium associated

with the insurance policy is paid by a manufacturer of the item (Col.4, lines 20-67).

The motivation for combining the respective teachings of Joao and Borghesi are as

discussed above in the rejection of claims 1 and 10, and incorporated herein.

(L)   As per claim 12, Borghesi discloses the method wherein the item is an automobile

of a particular make and a model (Col.9, lines 57-67 to Col.10, line 28).

The motivation for combining the respective teachings of Joao and Borghesi are as

discussed above in the rejection of claims 1 and 10, and incorporated herein.

(M)   As per claim 13, Borghesi discloses the method wherein the insurance policy

covers   comprehensive losses relating to the item (Col.10, lines 6-67).

The motivation for combining the respective teachings of Joao and Borghesi are as

discussed above in the rejection of claims 1 and 10, and incorporated herein.

(N)   As per claim 14, Borghesi discloses the method wherein the insurance policy

covers collision losses relating to the item (Col.9, lines 7-67 to Col.10, line 28).

The motivation for combining the respective teachings of Joao and Borghesi are as

discussed above in the rejection of claims 1 and 10, and incorporated herein.

(O)   As per claim 15, Borghesi discloses the method wherein the insurance policy is

provided without consideration of further characteristics of the buyer (Col.9, lines 7-67).

The motivation for combining the respective teachings of Joao and Borghesi are as

discussed above in the rejection of claim 1, and incorporated herein.

(P) As per claim 16, Borghesi discloses the method wherein the insurance policy covers

all users of the item (Col.15, lines 24-67 to Col.16, line 67).

The motivation for combining the respective teachings of Joao and Borghesi are as

discussed above in the rejection of claims 1 and 10, and incorporated herein.

(Q)   As per claim 17, Joao discloses the method wherein the insurance policy remains

in effect if the buyer moves from the geographic region (Col.2, lines 19-49).

(R)   As per claim 18, Joao discloses a method for using a computer system to provide

an insurance policy relating to a sale or lease of an item (Col.1, lines 6-65); determining

on said computer system a premium for the insurance policy (See Joao Col.2, lines 19-

67; Col.5, lines 6-13).

Joao does not explicitly disclose receiving an indication of an item sold to a buyer

for which insurance is provided by a third party; charging a premium for the insurance

policy to the third party, the premium based on a class of the item and a geographic

region of the buyer without consideration of further qualifications of the buyer.

However, these features are known in the art, as evidenced by Borghesi. In

particular, Borghesi suggests receiving an indication of an item sold to a buyer for which

insurance is provided by a third party (Col.9, lines 18-67 to Col.10, line 45); charging a

premium for the insurance policy to the third party (Col.13, lines 12-67), the premium

based on a class of the item and a geographic region of the buyer without consideration

of further qualifications of the buyer (Col.9, lines 7-67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Borghesi within the system of Joao with the

motivation of providing insurance policies, products, services and/or coverage for

leased and /or rented entities, vehicle, premises, equipment and other appropriate

articles on, or over, a communication network such as on, or over, the Internet, the

World Wide Web and /or any other communications and /or network environment and

/or medium (See Joao, Col.5, lines 6-13).

(S)   As per claim 19, Joao discloses a method for using a computer system to

determine an insurance premium to be charged to a party providing insurance to a

buyer of an item (Col.1, lines 6-67), comprising: calculating on said computer system a

premium to be charged for each insurance policy issued to purchasers or lessees in the

geographic area (Col.2, lines 18-67). Joao does not explicitly disclose receiving, from a

manufacturer, an indication of a class of items for which insurance is to be provided to a

buyer of one of the class of items; receiving, from a manufacturer, an indication of a

geographic region in which a buyer must reside to receive the insurance, the premium

being based on the class of items and the geographic region, without consideration of

further characteristics of the buyer.

However, these features are known in the art, as evidenced by Borghesi. In

particular, Borghesi suggests receiving, from a manufacturer, an indication of a class of

items for which insurance is to be provided to a buyer of one of the class of items

(Col.4, lines 20-67); receiving, from a manufacturer, an indication of a geographic region

in which a buyer must reside to receive the insurance (Col.4, lines 20-67, the premium being based on the class of items and the geographic region, without consideration of further characteristics of the buyer (Col.9, lines 7-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(T) As per claim 20, Joao discloses a method of using a computer system to store receipt of an insurance policy with a sale or lease of an item (Col.1, lines 6-67; Col.8, lines 1-67 ; Col.17, lines 13-33) , comprising: completing a sales agreement for one of a purchase and a lease of an item (Col.2, lines 50-67 to Col.3, line 21); and storing a indicator of receipt of said paid-up insurance policy in said computer system (Col.1, lines 6-67; Col.8, lines 1-67 ; Col.17, lines 13-33).

Joao does not explicitly disclose receiving a paid-up insurance policy for the item as part of the sales agreement, the insurance policy being provided based on a class of the item and the geographic location in which the buyer resides.

However, this feature is known in the art, as evidenced by Borghesi. In particular, Borghesi suggests receiving a paid-up insurance policy for the item as part of the sales

agreement, the insurance policy being provided based on a class of the item and the geographic location in which the buyer resides (See Borghesi, Col.9, lines 8-67 to Col.10, line 28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(U)   As per claim 21, Joao discloses an apparatus for providing an incentive relating to a sale or lease of an item (Col.5, lines 38-67 to Col.6, line 67), comprising: means for determining a class of items for which insurance is to be provided with a sale or lease of one of the class of items (Col.5, lines 6-13); means for determining a geographic region in which a buyer of one of the class of items must reside to receive the insurance (Col.2, lines 8-57); and means for paying an insurance premium for an insurance policy on behalf of the buyer (Col.7, lines 15-67 to Col.8, line 67).

Joao does not explicitly disclose the insurance policy covering an item from the class of items after a sale or lease of the item to the buyer residing in the geographic region.

However, this feature is known in the art, as evidenced by Borghesi. In particular, Borghesi suggests the insurance policy covering an item from the class of items after a

sale or lease of the item to the buyer residing in the geographic region (See Borghesi,

Col.9, lines 18-67 to Col.10, line 28).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Borghesi within the system of Joao with the

motivation of providing insurance policies, products, services and/or coverage for

leased and /or rented entities, vehicle, premises, equipment and other appropriate

articles on, or over, a communication network such as on, or over, the Internet, the

World Wide Web and /or any other communications and /or network environment and

/or medium (See Joao, Col.5, lines 6-13).

(V)   As per claim 22, Joao discloses an apparatus for providing an incentive relating

to a sale or lease of an item, comprising: a processor (Col.5, lines 38-67); and a

memory in electrical communication with the processor, the memory for storing a

plurality of processing instructions for enabling the processor to: determine a class of

items for which insurance is to be provided with a sale or lease of one of the class of

items (Col.5, lines 38-67); determine a geographic region in which a buyer of one of the

class of items must reside to receive the insurance (Col.5, lines 38-67 to Col.6, line 67);

and provide electronic payment of an insurance premium for an insurance policy on

behalf of the buyer (Col.7, lines 15-67 to Col.8, line 67).

Joao does not explicitly disclose the insurance policy covering an item from the

class of items after a sale or lease of the item to the buyer residing in the geographic

region.

However, this feature is known in the art, as evidenced by Borghesi. In particular, Borghesi suggests the insurance policy covering an item from the class of items after a sale or lease of the item to the buyer residing in the geographic region (See Borghesi, Col.9, lines 18-67 to Col.10, line 28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(W)   As per claim 23, Joao discloses a computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for providing an incentive relating to a sale or lease of an item (Col.5, lines 38-67 to Col.6, line 24), the method comprising: determining a class of items for which insurance is to be provided with a sale or lease of one of the class of items (Col.5, lines 38-67); determining a geographic region in which a buyer of one of the class of items must reside to receive the insurance (Col.5, lines 38-67 to Col.6, line 67); and paying an insurance premium for an insurance policy on behalf of the buyer (Col.7, lines 15-67 to Col.8, line 67). Joao does not explicitly disclose the insurance policy covering an item

from the class of items after a sale or lease of the item to the buyer residing in the geographic region.

However, this feature is known in the art, as evidenced by Borghesi. In particular, Borghesi suggests the insurance policy covering an item from the class of items after a sale or lease of the item to the buyer residing in the geographic region (See Borghesi, Col.9, lines 18-67 to Col.10, line 28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(X)   As per claim 24, Joao discloses an apparatus for providing an incentive relating to a sale or lease of an item, comprising: means for receiving an indication of a class of items for which insurance is to be provided to a buyer residing in a geographic region (Col.5, lines 38-67 to Col.6, line 24); means for completing a sale or lease of one of the class of items to a particular buyer residing in the geographic region (Col.5, lines 38-67 to Col.6, line 67); means for confirming that the buyer resides in the geographic region (Col.2, lines 9-67). Joao does not explicitly disclose means for providing, in a sales

agreement relating to the sale or lease of the item, a confirmation of a provision of an insurance policy covering a loss relating to the item.

However, these features are known in the art, as evidenced by Borghesi. In particular, Borghesi suggests means for providing, in a sales agreement relating to the sale or lease of the item, a confirmation of a provision of an insurance policy covering a loss relating to the item (See Borghesi, Col.9, lines 8-67 to Col.10, line 45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(Y)   As per claim 25, Joao discloses an apparatus for providing an incentive relating to a sale or lease of an item, comprising: a processor (Col.5, lines 38-67); and a memory in electrical communication with the processor, the memory for storing a plurality of processing instructions for enabling the processor to: receive an indication of a class of items for which insurance is to be provided to a buyer residing in a geographic region (Col.5, lines 38-67); complete a sale or lease of one of the class of items to a particular buyer residing in the geographic region (Col.7, lines 23-67 to Col.8, line 67). Joao does not explicitly disclose confirm that the buyer resides in the

geographic region; and provide, in a sales agreement relating to the sale or lease of the item, a confirmation of a provision of an insurance policy covering a loss relating to the item.

However, these features are known in the art, as evidenced by Borghesi. In particular, Borghesi suggests confirm that the buyer resides in the geographic region; and provide, in a sales agreement relating to the sale or lease of the item, a confirmation of a provision of an insurance policy covering a loss relating to the item (See Borghesi, Col.9, lines 8-67 to Col.10, line 45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(Z)   As per claim 26, Joao discloses a computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for providing an incentive relating to a sale or lease of an item, the method comprising: receiving an indication of a class of items for which insurance is to be provided to a buyer residing in a geographic region (Col.1, lines 6-65); completing a sale or lease of

one of the class of items to a particular buyer residing in the geographic region (Col.2, lines 8-57).

Joao does not explicitly disclose confirming that the buyer resides in the geographic region; and providing, in a sales agreement relating to the sale or lease of the item, a confirmation of a provision of an insurance policy covering a loss relating to the item.

However, these features are known in the art, as evidenced by Borghesi. In particular, Borghesi suggests confirming that the buyer resides in the geographic region; and providing, in a sales agreement relating to the sale or lease of the item, a confirmation of a provision of an insurance policy covering a loss relating to the item (See Borghesi, Col.4, lines 20-67 to Col.5, lines 25; Col.17, lines 1-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(AA)   As per claim 27, Joao discloses an apparatus for determining an insurance premium to be charged to a party providing insurance to a buyer of an item (Col.1, lines

6-67) comprising: means for calculating a premium to be charged for each insurance

policy issued to purchasers or lessees in the geographic area (Col.1, lines 6-67).

Joao does not explicitly disclose means for receiving, from a manufacturer, an

indication of a class of items for which insurance is to be provided to a buyer of one of

the class of items; means for receiving, from a manufacturer, an indication of a

geographic region in which a buyer must reside to receive the insurance; the premium

being based on the class of items and the geographic region, without consideration of

further characteristics of the buyer.

However, these features are known in the art, as evidenced By Borghesi. In

particular, Borghesi suggests means for receiving, from a manufacturer, an indication of

a class of items for which insurance is to be provided to a buyer of one of the class of

items (Col.4, lines 20-67); means for receiving, from a manufacturer, an indication of a

geographic region in which a buyer must reside to receive the insurance (Col.4, lines

20-67); the premium being based on the class of items and the geographic region,

without consideration of further characteristics of the buyer (See Borghesi, Col.9, lines

7-67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Borghesi within the system of Joao with the

motivation of providing insurance policies, products, services and/or coverage for

leased and /or rented entities, vehicle, premises, equipment and other appropriate

articles on, or over, a communication network such as on, or over, the Internet, the

World Wide Web and /or any other communications and /or network environment and

/or medium (See Joao, Col.5, lines 6-13).

(BB)   As per claim 28, Joao discloses an apparatus for determining an insurance

premium to be charged to a party providing insurance to a buyer of an item (Col.1, lines

6-67), comprising: a processor (Col.5, lines 38-67); and a memory in electrical

communication with the processor, the memory for storing a plurality of processing

instructions for enabling the processor to (Col.5, lines 38-67 to Col.6, line 67): and

calculate a premium to be charged for each insurance policy issued to purchasers or

lessees in the geographic area (Col.2, lines 18-67).

Joao does not explicitly disclose receive, from a manufacturer, an indication of a

class of items for which insurance is to be provided to a buyer of one of the class of

items; receive, from a manufacturer, an indication of a geographic region in which a

buyer must reside to receive the insurance; the premium being based on the class of

items and the geographic region, without consideration of further characteristics of the

buyer.

However, these features are known in the art, as evidenced By Borghesi. In

particular, Borghesi suggests receive, from a manufacturer, an indication of a class of

items for which insurance is to be provided to a buyer of one of the class of items

(Col.4, lines 20-67); receive, from a manufacturer, an indication of a geographic region

in which a buyer must reside to receive the insurance (Col.4, lines 20-67); the premium

being based on the class of items and the geographic region, without consideration of further characteristics of the buyer (Col.2, lines 18-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(CC)   As per claim 29, Joao discloses a computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for determining an insurance premium to be charged to a party providing insurance to a buyer of an item (Col.1, lines 6-67), and calculating a premium to be charged for each insurance policy issued to purchasers or lessees in the geographic area (Col.2, lines 18-67).

Joao does not explicitly disclose the method comprising: receiving, from a manufacturer, an indication of a class of items for which insurance is to be provided to a buyer of one of the class of items; receiving, from a manufacturer, an indication of a geographic region in which a buyer must reside to receive the insurance; the premium being based on the class of items and the geographic region, without consideration of further characteristics of the buyer.

However, these features are known in the art, as evidenced By Borghesi. In particular, Borghesi suggests the method comprising: receiving, from a manufacturer, an indication of a class of items for which insurance is to be provided to a buyer of one of the class of items (Col.4, lines 20-67); receiving, from a manufacturer, an indication of a geographic region in which a buyer must reside to receive the insurance (Col.4, lines 20-67); the premium being based on the class of items and the geographic region, without consideration of further characteristics of the buyer (Col.2, lines 18-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(DD)   As per claim 30, Joao discloses a method for providing an incentive relating to a sale of an item (Col.5, lines 1-13), comprising: offering an item for sale, the item belonging to a class of items for which, insurance is to be provided to a buyer residing in a determined geographic region without consideration of a further characteristic of the buyer (Col.5, lines 38-67 to Col.6, line 67).

Joao does not explicitly disclose offering to provide an insurance policy for the item covering the buyer upon entering into a sales agreement with the buyer.

However, this feature is known in the art, as evidenced by Borghesi. In particular,

Borghesi suggests offering to provide an insurance policy for the item covering the

buyer upon entering into a sales agreement with the buyer (Col.9, lines 18-67 to Col.10,

line 45).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Borghesi within the system of Joao with the

motivation of providing insurance policies, products, services and/or coverage for

leased and /or rented entities, vehicle, premises, equipment and other appropriate

articles on, or over, a communication network such as on, or over, the Internet, the

World Wide Web and /or any other communications and /or network environment and

/or medium (See Joao, Col.5, lines 6-13).

(EE)   As per claim 31, Joao discloses the method wherein the insurance policy covers

the item after a sale of the item to the buyer residing in the geographic region (Col.6,

lines 1-67).

(FF)   As per claim 32, Joao discloses the method further comprising: entering into a

sales agreement with the buyer (Col.11, lines 18-67).

(GG) As per claim 33, Joao discloses the method further comprising: paying a

premium to an insurance provider for the insurance for the item (Col.11, lines 33-67 to

Col.12, line 67).

(HH)   As per claim 34, Joao discloses the method wherein the insurance policy has a
maximum term of one year (Col.13, lines 39-67 to Col.14, line 67).

(II)   As per claim 35, Joao discloses the method wherein said sale comprises a lease
of the item and said buyer comprises a lessor (Col.1, lines 5-67).

(JJ)   As per claim 45, Joao discloses a method for providing an incentive relating to a
lease of an item, comprising: offering an item for lease, the item belonging to a class of
items for which insurance is to be provided to a lessor residing in a determined
geographic region without consideration of a further characteristic of the lessor (Col.5,
lines 38-67 to Col.6, line 67).

Joao does not explicitly disclose offering to provide an insurance policy for the
item covering the lessor upon entering into a lease agreement with the lessor.

However, this feature is known in the art, as evidenced by Borghesi. In particular,
Borghesi suggests an insurance policy for the item covering the lessor upon entering
into a lease agreement with the lessor (Col.9, lines 18-67 to Col.10, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the
invention to have included the feature of Borghesi within the system of Joao with the
motivation of providing insurance policies, products, services and/or coverage for
leased and /or rented entities, vehicle, premises, equipment and other appropriate
articles on, or over, a communication network such as on, or over, the Internet, the

World Wide Web and /or any other communications and /or network environment and

/or medium (See Joao, Col.5, lines 6-13).

(KK)   Claims 36-44 and 46-58 recite the underlying process of the elements of claims

2-9, 12-17 and 31-35, and respectively. As the various elements of claims 2-9, 12-17

and 31-35 have been shown to be either disclosed by or obvious in view of the

collective teachings of Joao and Borghesi, it is readily apparent that the apparatus

disclosed by the applied prior art performs the recited underlying functions. As such, the

limitations recited in claims 36-44 and 46-58 are rejected for the same reasons given

above for system claims 2-9, 12-17 and 31-35, and incorporated herein.

(LL)   As per claim 59, Joao discloses the method wherein the insurance premium is

the same for each of the class of items leased in the geographic region (Col.5, lines 38-

67 to Col.6, line 67).

(MM) As per claim 60, Joao discloses a method for providing an insurance policy

relating to a lease of an item (Col.5, lines 38-67 to Col.6, line 67), comprising: receiving

an indication of an item leased to a lessor for which insurance is provided by a third

party (Col.1, lines 6-67).

Joao does not explicitly disclose charging a premium for the insurance policy to

the third party, the premium based on a class of the item and a geographic region of the

buyer without consideration of further qualifications of the lessor.

However, this feature is known in the art, as evidenced by Borghesi. In particular,

Borghesi suggests charging a premium for the insurance policy to the third party, the

premium based on a class of the item and a geographic region of the buyer without

consideration of further qualifications of the lessor (See Borghesi, Col.9, lines 18-67 to

Col.10, line 45).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Borghesi within the system of Joao with the

motivation of providing insurance policies, products, services and/or coverage for

leased and /or rented entities, vehicle, premises, equipment and other appropriate

articles on, or over, a communication network such as on, or over, the Internet, the

World Wide Web and /or any other communications and /or network environment and

/or medium (See Joao, Col.5, lines 6-13).

(NN)   As per claim 61, Joao discloses a method for determining an insurance premium

to be charged to a party providing insurance to a lessor of an item (Col.1, lines 6-67),

comprising: calculating a premium to be charged for each insurance policy issue to the

lessor in the geographic region (Col.2, lines 18-67).

Joao does not explicitly disclose receiving, from a manufacturer, an indication of

a class of items for which insurance is to be provided to a lessor of one of the class of

items; receiving, from a manufacturer, an indication of a geographic region in which the

lessor must reside to receive the insurance; the premium being based on the class of

items and the geographic region, without consideration of further characteristics of the lessor.

However, these features are known in the art, as evidenced By Borghesi. In particular, Borghesi suggests receiving, from a manufacturer, an indication of a class of items for which insurance is to be provided to a lessor of one of the class of items (Col.4, lines 20-67; receiving, from a manufacturer, an indication of a geographic region in which the lessor must reside to receive the insurance (Col.4, lines 20-67); the premium being based on the class of items and the geographic region, without consideration of further characteristics of the lessor (Col.2, lines 18-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(OO) As per claim 62, Joao discloses a method for determining an insurance premium to be charged to a party providing insurance to a buyer of an item (Col.1, lines 6-67), comprising: calculating a premium to be charged for each insurance policy issued to the buyer (Col.2, lines 18-67).

Joao does not explicitly disclose receiving an indication of a class of items for which insurance is to be provided to a buyer of one of the class of items; receiving an indication of a geographic region in which the buyer must reside to receive the insurance, the premium being based on the class of items and the geographic region, without consideration of further characteristics of the buyer.

However, these features are known in the art, as evidenced By Borghesi. In particular, Borghesi suggests receiving an indication of a class of items for which insurance is to be provided to a buyer of one of the class of items (Col.4, lines 20-67); receiving an indication of a geographic region in which the buyer must reside to receive the insurance (Col.4, lines 20-67), the premium being based on the class of items and the geographic region, without consideration of further characteristics of the buyer (Col.2, lines 18-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(PP)   As per claim 63, Joao discloses an apparatus for determining an insurance premium to be charged to a party providing insurance to a buyer of an item (Col.1, lines

6-67), comprising: means for calculating a premium to be charged for each insurance policy issued to the buyer (Col.2, lines 18-67).

Joao does not explicitly disclose means for receiving an indication of a class of items for which insurance is to be provided to a buyer of one of the class of items means for receiving an indication of a geographic region in which the buyer must reside to receive the insurance; the premium being based on the class of items and the geographic region, without consideration of further characteristics of the buyer.

However, these features are known in the art, as evidenced By Borghesi. In particular, Borghesi suggests means for receiving an indication of a class of items for which insurance is to be provided to a buyer of one of the class of items (Col.4, lines 20-67); means for receiving an indication of a geographic region in which the buyer must reside to receive the insurance (Col.4, lines 20-67); the premium being based on the class of items and the geographic region, without consideration of further characteristics of the buyer (Col.2, lines 18-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(QQ)   As per claim 64, Joao discloses an apparatus for determining an insurance premium to be charged to a party providing insurance to a buyer of an item (Col.1, lines 6-67), comprising: a processor (Col.5, lines 38-67) and a memory in communication with the processor, the memory for storing a plurality of processing instructions enabling the processor to (Col.5, lines 38-67 to Col.6, line 67): calculate a premium to be charged for each insurance policy issued to the buyer (Col.2, lines 18-67).

Joao does not explicitly disclose receive an indication of a class of items for which insurance is to be provided to a buyer of one of the class of items; receive an indication of a geographic region in which the buyer must reside to receive the insurance; the premium being based on the class of items and the geographic region, without consideration of further characteristics of the buyer.

However, these features are known in the art, as evidenced By Borghesi. In particular, Borghesi suggests receive an indication of a class of items for which insurance is to be provided to a buyer of one of the class of items (Col.4, lines 20-67); receive an indication of a geographic region in which the buyer must reside to receive the insurance (Col.4, lines 20-67); the premium being based on the class of items and the geographic region, without consideration of further characteristics of the buyer (See Borghesi, Col.2, lines 18-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate

articles on, or over, a communication network such as on, or over, the Internet, the

World Wide Web and /or any other communications and /or network environment and

/or medium (See Joao, Col.5, lines 6-13).

(RR)   As per claim 65, Joao discloses a computer-readable medium encoded with

processing instructions for implementing a method, performed by a computer, for

determining an insurance premium to be charged to a party providing insurance to a

buyer of an item (Col.5, lines 38-67 to Col.6, line 67), calculating a premium to be

charged for each insurance policy issued to the buyer (Col.2, lines 18-67).

Joao does not explicitly disclose the method comprising: receiving an indication

of a class of items for which insurance is to be provided to a buyer of one of the class of

items; receiving an indication of a geographic region in which the buyer must reside to

receive the insurance; the premium being based on the class of items and the

geographic region, without consideration of further characteristics of the buyer.

However, these features are known in the art, as evidenced By Borghesi. In

particular, Borghesi suggests receiving an indication of a class of items for which

insurance is to be provided to a buyer of one of the class of items (Col.4, lines 20-67);

receiving an indication of a geographic region in which the buyer must reside to receive

the insurance (Col.4, lines 20-67); the premium being based on the class of items and

the geographic region, without consideration of further characteristics of the buyer

(Col.2, lines 18-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(SS)   As per claim 66, Joao discloses a method for determining an insurance premium to be charged to a party providing insurance to a lessor of an item (Col.6, lines 7-67), comprising: calculating a premium to be charged for each insurance policy issued to the lessor in the geographic region (Col.2, lines 18-67).

Joao does not explicitly disclose receiving an indication of a class of items for which insurance is to be provided to a lessor of one of the class of items; receiving an indication of a geographic region in which the lessor must reside to receive the insurance; the premium being based on the class of items and the geographic region, without consideration of further characteristics of the lessor.

However, these features are known in the art, as evidenced By Borghesi. In particular, Borghesi suggests receiving an indication of a class of items for which insurance is to be provided to a lessor of one of the class of items (Col.4, lines 20-67); receiving an indication of a geographic region in which the lessor must reside to receive the insurance (Col.4, lines 20-67); the premium being based on the class of items and

the geographic region, without consideration of further characteristics of the lessor

(Col.2, lines 18-67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Borghesi within the system of Joao with the

motivation of providing insurance policies, products, services and/or coverage for

leased and /or rented entities, vehicle, premises, equipment and other appropriate

articles on, or over, a communication network such as on, or over, the Internet, the

World Wide Web and /or any other communications and /or network environment and

/or medium (See Joao, Col.5, lines 6-13).

(TT)   As per claim 67, Joao discloses an apparatus for determining an insurance

premium to be charged to a party providing insurance to a lessor of an item (Col.6, lines

7-67), comprising: means for calculating a premium to be charged for each insurance

policy issued to the lessor in the geographic region (Col.6, lines 7-67).

Joao does not explicitly disclose means for receiving an indication of a class of

items for which insurance is to be provided to a lessor of one of the class of items;

means for receiving an indication of a geographic region in which the lessor must reside

to receive the insurance; and the premium being based on the class of items and the

geographic region, without consideration of further characteristics of the lessor.

However, these features are known in the art, as evidenced By Borghesi. In

particular, Borghesi suggests means for receiving an indication of a class of items for

which insurance is to be provided to a lessor of one of the class of items (Col.4, lines

20-67); means for receiving an indication of a geographic region in which the lessor

must reside to receive the insurance (Col.4, lines 20-67); and the premium being based

on the class of items and the geographic region, without consideration of further

characteristics of the lessor (Col.2, lines 18-67; Col.5, lines 1-67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Borghesi within the system of Joao with the

motivation of providing insurance policies, products, services and/or coverage for

leased and /or rented entities, vehicle, premises, equipment and other appropriate

articles on, or over, a communication network such as on, or over, the Internet, the

World Wide Web and /or any other communications and /or network environment and

/or medium (See Joao, Col.5, lines 6-13).

(UU)   As per claim 68, Joao discloses an apparatus for determining an insurance

premium to be charged to a party providing insurance to a lessor of an item (Col.5, lines

38-67 to Col.6, line 67), comprising: a processor (Col.5, lines 38-67); and a memory in

communication with the processor, the memory for storing a plurality of processing

instructions enabling the processor to (Col.5, lines 38-67 to Col.6, line 67): calculate a

premium to be charged for each insurance policy issued to the lessor in the geographic

region (Col.2, lines 18-67).

Joao does not explicitly disclose receive an indication of a class of items for

which insurance: is to be provided to a lessor of one of the class of items; receive an

indication of a geographic region in which the lessor must reside to receive the

insurance; the premium being based on the class of items and the geographic region, without consideration of further characteristics of the lessor.

However, these features are known in the art, as evidenced By Borghesi. In particular, Borghesi suggests receive an indication of a class of items for which insurance is to be provided to a lessor of one of the class of items (Col.4, lines 20-67); receive an indication of a geographic region in which the lessor must reside to receive the insurance (Col.4, lines 20-67; the premium being based on the class of items and the geographic region, without consideration of further characteristics of the lessor (Col.2, lines 18-67; Col.5, lines 1-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(VV)   As per claim 69, Joao discloses a computer-readable medium encoded with processing instructions for implementing a method, performed by a computer, for determining an insurance premium to be charged to a party providing insurance to a lessor of an item (Col.5, lines 38-67), the method comprising: calculating a premium to

be charged for each insurance policy issued to the lessor in the geographic region (Col.2, lines 18-67).

Joao does not explicitly disclose receiving an indication of a class of items for which insurance is to be provided to a lessor of one of the class of items; receiving an indication of a geographic region in which the lessor must reside to receive the insurance; the premium being based on the class of items and the geographic region, without consideration of further characteristics of the lessor.

However, these features are known in the art, as evidenced By Borghesi. In particular, Borghesi suggests receiving an indication of a class of items for which insurance is to be provided to a lessor of one of the class of items (Col.4, lines 20-67); receiving an indication of a geographic region in which the lessor must reside to receive the insurance (Col.4, lines 20-67); the premium being based on the class of items and the geographic region, without consideration of further characteristics of the lessor (Col.2, lines 18-67; Col.5, lines 1-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

(WW) As per claim 70, Joao discloses a method of receiving an insurance policy with a lease of an item, performed by a lessor (Col.6, lines 1-67), comprising: completing a sales agreement for a purchase of an item (Col.9, lines 1-67 to Col.10, line 67). Joao does not explicitly disclose receiving a paid-up insurance policy for the item, the insurance policy being provided based on a class of the item and the geographic location in which the lessor resides.

However, this feature is known in the art, as evidenced by Borghesi. In particular, Borghesi suggests receiving a paid-up insurance policy for the item, the insurance policy being provided based on a class of the item and the geographic location in which the lessor resides (See Borghesi, Col.9, lines 8-67 to Col.10, lines 28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghesi within the system of Joao with the motivation of providing insurance policies, products, services and/or coverage for leased and /or rented entities, vehicle, premises, equipment and other appropriate articles on, or over, a communication network such as on, or over, the Internet, the World Wide Web and /or any other communications and /or network environment and /or medium (See Joao, Col.5, lines 6-13).

Response to Arguments

6.   Applicant's arguments filed 09/08/03 regarding claims 1,10,18-20 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 09/08/03.

(A)   At pages 20-24 of the o9/08/03 response, Applicant's argues the followings:

(1) Neither Joao nor Borghesi teaches or suggests providing insurance with a sale or lease of an item.

(2) Neither Joao's method of providing insurance of a leased item, nor Borghesi either alone or in combination, teach or suggest providing insurance with a sale or lease of an item.

(3) The cited references do not teach or suggest charging a premium that is solely based on a class of the item and the geographic region of the buyer, without considering other qualifications of the buyer.

(4) Joao does not disclose receiving an indication of an item sold to a buyer for which insurance is provided by a third party.

(5) Joao and Borghesi do not teach or suggest receiving a paid-up insurance policy for an item as part of a sales agreement.

(A)   With respect to Applicant's first argument, Examiner respectfully suggests that Joao discloses "The apparatus 100 also comprises a read only memory (ROM) 2 and a random access memory (RAM) 3 which are also connected to the CPU 1. The apparatus 100 also comprises a user input device(s) 4 which comprise(s) any one or more of a keyboard, a scanner, a user pointing device, such as, for example, a mouse, a touch pad, and/or an audio input device and/or a video input device, etc., if desired, which input device(s) are also be connected to the CPU 1. The apparatus 100 also comprises a display device 5, such as a display monitor, which is also connected to the CPU 1, and an output device 6, such as a printer, a fax/modem, etc., which output

device is also connected to the CPU 1. The apparatus 100 also comprises a

database(s) 7, wherein various information and/or data, which is utilized in the various

processing routines, as will be described herein, is stored and which is also connected

to, and accessible by, the CPU 1. Various data and/or information related to the leasing

and/or rental of vehicles, motor vehicles, trucks, construction equipment, farm

equipment, boats, recreational vehicles, airplanes, aircraft, motorcycles, office

equipment, computers, computer equipment, and other articles and/or devices,

equipment, etc., including articles and/or equipment which may be utilized in, and/or in

conjunction with residential and/or commercial premises, is stored in the database 7.

The database 7 also includes data and/or information related to the leases of residential

and/or commercial property and/or premises. Data and/or information related to vehicle

leases, which is included in the database 7, includes vehicle year, model, vehicle

components and/or systems along with their repair costs, replacement costs, probability

of damage, probability of post-warranty repairs necessitated by wear and tear, damage,

malfunctioning components and/or systems and defects in materials, parts,

components, systems and/or workmanship, average costs for repairs, historical leasing

data, average total excess wear and tear and/or damage costs for the entire vehicle.

Vehicle leasing data and/or information also includes locality, regional and geographical

data which is correlated with excess wear and tear and/or damage costs along with data

and/or information which is related to driving and/or usage habits and/or patterns in a

given area or areas. Data and information related to individuals and/or business entities,

by region, occupation etc, including driving and/or usage habits, leasing histories, etc.,

will also be included in the database 7. Excess wear and tear and damage, as the terms

are used herein, refer to, and includes, any and all conditions and/or states of the

leased and/or rented entity, including but not limited to scratches, dents, tears, stains,

etc, malfunctioning and/or inoperable components and/or systems, state(s) of disrepair,

and any and all other states and/or conditions which will subject the lessor and/or renter

to any liability therefor at the end of the lease and/or rental term. Post-warranty repairs,

as the term is used herein, includes any and all repairs which are made necessary

from any wear and tear, normal or otherwise, to components and/or systems of the

herein-described entities and further includes repairs which result from defects in

materials and/or workmanship. Post-warranty repairs also include any and all repairs

which would be covered under a manufacturer's warranty. In this regard, the apparatus

and method of the present invention provides for extended warranty protection for the

leased and/or rented entity for the duration of the lease or rental term. The database 7

also includes any and all data and/or information which will facilitate the calculation,

determination and/or formulation of an insurance policy, product, service and/or

coverage for providing extended warranty protection for any leased and/or rented entity

described herein. The database 7 also includes data and/or information for particular

individuals and/or business entities which includes personal, individual and/or

organizational driving and/or usage patterns and/or driving and/or usage histories and

leasing histories as well as any other information which an insurer may deem

necessary and/or desirable in determining whether insurance should be offered and/or

underwritten for an individual and/or business entity. Data and/or information related to

the leasing and/or rental of any other leasable article and/or entity, such as, for example, personal, residential and/or commercial office equipment, computers, computer equipment, facsimile machines, copy machines, furniture, as well as any other article, piece of equipment and/or entity (hereinafter referred to as "leasable article"), which may be the subject of a lease or rental arrangement, is also included in the database 7" which correspond to Applicant's claimed feature (See Joao, Col.5, lines 47-67 to Col.6, line65). Therefore, Applicant's argument is not persuasive.

(B)   With respect to Applicant's second argument, Examiner respectfully suggests that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 7) of the previous Office Action. Moreover, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular motivation and/or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time

of the invention that support a holding of obviousness. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In addition, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(C)   With respect to Applicant's third argument, Examiner respectfully suggests Joao discloses "Data and/or information related to vehicle leases, which is included in the database 7, includes vehicle year, model, vehicle components and/or systems along with their repair costs, replacement costs, probability of damage, probability of post-warranty repairs necessitated by wear and tear, damage, malfunctioning components and/or systems and defects in materials, parts, components, systems and/or workmanship, average costs for repairs, historical leasing data, average total excess wear and tear and/or damage costs for the entire vehicle. Vehicle leasing data and/or

information also includes locality, regional and geographical data which is correlated

with excess wear and tear and/or damage costs along with data and/or information

which is related to driving and/or usage habits and/or patterns in a given area or areas.

Data and information related to individuals and/or business entities, by region,

occupation etc, including driving and/or usage habits, leasing histories, etc., will also be

included in the database 7" which correspond to Applicant's claimed feature (See Joao,

Col.6, lines 7-25). Therefore, Applicant's argument's is not persuasive.

(D)   With respect to Applicant's fourth and fifth arguments, Examiner respectfully

suggests Joao suggests "The database 7 also comprises data and/or information

related to insurance premiums which data and/or information is utilized to calculate

and/or underwrite an insurance policy, depending upon the nature and the amount of

 coverage for the leased and/or rented entity of interest. The database 7 also contains

statistical information related to sex, age, driving and use record histories for individuals

and/or business entities which information can be utilized in insurance policy and/or

premium determinations and calculations. The database 7 also comprises data and/or

information concerning past lease experiences, if any, for individuals and business

entities, including specific individuals and/or business entities, along with corresponding

records concerning any end of lease damage and/or excess wear and tear which may

have occurred in past leasing and/or rental relationships. The database 7 also contains

data and/or information related to lease and or rental term, data and/or information

related to geography, season, etc., along with data and/or information related to how

these variables affect any other data and/or information described herein. The data and/or information which is stored in the database 7, in addition to the above data and/or information, contains any other necessary, recommended and/or supplemental data and/or information, and/or application program(s) which may be helpful and/or desired by an insurer in determining whether to issue an insurance policy, product, service and/or coverage described herein. The data and/or information which is stored in the database 7 may be utilized to calculate risk, risk of loss and/or damage probabilities for an individual and/or business entity, for any given lease or rental situation, lease or rental entity and/or lease and/or rental agreement. The data and/or information which is stored in the database 7 may be utilized to calculate risk, risk of loss and/or damage probabilities for any of the leased and/or rented vehicles, articles and/or premises described herein, for any individual and/or business entity and for any given lease and/or rental situation. The present invention may be utilized to custom design and/or calculate an insurance policy, product, service and/or coverage for a particular lease or rental agreement and/or situation by utilizing risk, risk of loss, risk assessment and underwriting techniques which can be modified for the particular application. The data and/or information described herein will be utilized to generate and underwrite an insurance policy as well as to calculate an insurance premium or charges, depending upon the nature and the amount of the coverage desired for the leased and/or rented entity. The data and/or information which is stored in the database 7 will be updated regularly so as to maintain the most accurate and current data as

possible" which correspond to Applicant's claimed feature (See Joao, Col.8, lines 12-64). Therefore, Applicant's argument is not persuasive.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 09/08/03 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Joao and Borghesi, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 7), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches motor vehicle monitoring system for determining a cost of insurance (5,797,134), insurance verification sytem and method (6,233,563) and method and apparatus for internet on-line insurance policy service (US 2002/0116228).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.
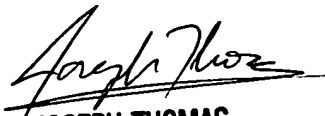
Art Unit: 3626

V. F
V.F
November 30, 2003

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
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